

The rejection based upon 35 U.S.C. 112, second paragraph should be withdrawn

In the non-final Office Action dated June 5, 2002, claim 10 was rejected under 35 U.S.C. § 112, second paragraph, as reciting the limitation “the corner” which lacked antecedent basis. In response to the June 5 Office Action, Applicants amended claim 10 to recite “carrier” rather than “corner” to correct an apparent typographical error. Accordingly, Applicants submitted that amended claim 10 was in compliance with 35 U.S.C. § 112, second paragraph, since the necessary antecedent basis for “carrier” could be found in base claim 9.

In the present Office Action dated October 23, 2002, however, the rejection of claim 10 under 35 U.S.C. § 112, second paragraph, was stated as being “sustained,” without any further explanation. Applicants therefore respectfully request further clarification or withdrawal of the rejection.

The rejection based upon 35 U.S.C. 112, first paragraph should be withdrawn

Claims 9-17 stand rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In particular, the Office Action contends on page 2 that claims 9 and 14 “do not have proper support in the original specification as filed because the specification does not provide any teaching or **discussion** on an evaluation device [recited in the claims] or **its usage with Applicant’s claimed temperature sensor ... [or] any other reference to the device and its connection** or even how it is connected.”

With regards to the evaluation device recited in claims 9 and 14, it is respectfully contended that adequate support is found at least on page 3, lines 21-24 of the Specification which states:

... the sensor has a layer 12, in which a conductor track 14 is embedded that is connected, in turn, via two contact points 16 to an evaluation device not depicted here.

A temperature can be determined by measuring a resistance of conductor track 14 ...

Thus, while the evaluation device is not graphically depicted, there is clear and express support in the original application for an evaluation device that is connected to a conductor track, as well as a temperature determination by measuring the resistance of the conductor track. It is

also clear that a person having ordinary skill in the art -- and even a layperson for that matter -- would understand that the evaluation device measures the resistance of the conductor track since it is the only device mentioned to be connected to the conductor track and since this mention of the connected evaluation device is immediately followed by the reference to the resistance measurement.

Moreover, the conclusion of adequate written disclosure is fully supported by the case law. In this regard, the specification as originally filed must, of course, provide a statutorily sufficient written description of the claimed subject matter to a person having ordinary skill. It does not matter, however, exactly how this is done so long as the written description requirement is satisfied. To determine whether the written description requirement is satisfied, the specification as a whole must be considered, and, in this regard, the Federal Circuit has made clear that the “claimed subject matter need not be described *in haec verba*” in the application for it to satisfy the written description requirement. See *In re Wright*, 9 U.S.P.Q.2d 1649, 1651 (Fed. Cir. 1989) (citing *In re Smith*, 481 F.2d 910, 914, 178 U.S.P.Q. 620, 624 (C.C.P.A. 1973)). See also M.P.E.P. § 2163.07 (stating that “[m]ere rephrasing of a passage does not constitute new matter.”).

Furthermore, the Examiner also has the initial burden of presenting “evidence or reasons why persons skilled in the art would not recognize in an applicant’s disclosure a description of the invention defined by the claims.” (See M.P.E.P. § 2163.04 (citing *In re Wertheim* 541 F.2d 257, 262, 265, 191 U.S.P.Q. 90, 96, 98 (C.C.P.A. 1976))) (emphasis added). The Manual of Patent Examining Procedure also provides that if an examiner rejects a claim based on the lack of a written description, the examiner should provide “reasons why persons skilled in the art would not recognize the description of this limitation in the disclosure of the application.” (See id.).

It is therefore respectfully submitted that claims 9-17 and the specification satisfy the first paragraph of 35 U.S.C. § 112, and that the rejection should therefore be withdrawn.

The rejection based upon Brandes should be withdrawn

Claims 9-17 stand rejected under 35 U.S.C. § 102(b) as being anticipated by, or in the alternative, rejected under 35 U.S.C. § 103(a) as being obvious over U.S. Patent No. 3,700,857 to Brandes et al. (hereafter “Brandes”). In response, Applicants respectfully submit that Brandes does not anticipate the pending claims, or render them obvious, since Brandes fails to disclose, or even suggest, each and every element in the claims, which the prior art reference must do for

anticipation and obviousness. (See Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631 (Fed. Cir. 1987); Northern Telecom, Inc. v. Datapoint Corp., 908 F.2d 931, 934 (Fed. Cir. 1990), cert. denied, 111 S. Ct. 296 (1990); In re Bond, 910 F.2d 831, 834 (Fed. Cir. 1990)). In particular, Brandes does not disclose “an evaluation device connected to the at least one conductor track configured to measure and evaluate a temperature-dependent change in a resistance of the at least one conductor track,” as recited in claim 9, nor does Brandes disclose a method of manufacturing a temperature sensor including the step of connecting an evaluation device to at least one conductor track, as recited in claim 14. Instead, Brandes merely teaches a device for uniformly heating an object (col. 1, lines 27-31; col. 2, lines 14-19), but Brandes lacks any discussion of temperature measurement or connection of an evaluation device.

The Examiner argues that “evaluation device” recited in amended claim 9 and new claim 14 is new matter, “and therefore such amendments have not been treated in this examination.” The Examiner’s argument is clearly incorrect. As mentioned in connection with the §112 rejection, the originally filed application clearly described an “evaluation device,” e.g., on page 3, lines 21-24, so there is no reasonable argument that an “evaluation device” is new matter. In addition, the fact that the “evaluation device” was not graphically depicted in the application does not mean that the “evaluation device” in the claims is new matter.

Accordingly, for at least these reasons, Applicants respectfully submit that Brandes does not anticipate, or render obvious, independent claims 9 and 14, as well as their dependent claims 10-13 and 15-17. Therefore, the rejection should be withdrawn.

The rejection based upon Toya should be withdrawn

Claims 9-17 also stand rejected under 35 U.S.C. § 102(b) as being anticipated by Toya. In response, Applicants respectfully submit that Toya does not anticipate the pending claims for the same reasons that Brandes does not anticipate claims 9-17. Specifically, Toya does not disclose “an evaluation device connected to the at least one conductor track configured to measure and evaluate a temperature-dependent change in a resistance of the at least one conductor track,” nor does Toya disclose a method of manufacturing a temperature sensor including the step of connecting an evaluation device to at least one conductor track. Instead, Toya merely discloses a spark plug electrode element made of sintered ceramic particles. (Col.2, lines 51-55).

Once again, the Examiner that “evaluation device” recited in claims 9 and 14 is new matter. As noted above, “evaluation device” was clearly described in the original application, and

Applicants respectfully submit that there is no reasonable argument that "evaluation device" recited in claims 9 and 14 is new matter.

Accordingly, for at least these reasons, Applicants respectfully submit that Toya does not anticipate independent claims 9 and 14, as well as their dependent claims 10-13 and 15-17. Therefore, the rejection should be withdrawn.

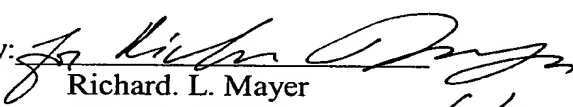
CONCLUSION

In view of the foregoing, Applicants assert that the present invention is new, non-obvious, and useful. Furthermore, all issues raised by the Examiner having been addressed, an early and favorable action on the merits is earnestly solicited.

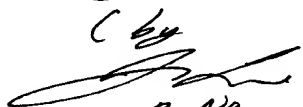
Respectfully submitted,

KENYON & KENYON

Dated: 1/10, 2003

By: 
Richard. L. Mayer
Reg. No. 22,490

CUSTOMER NO. 26646
PATENT TRADEMARK OFFICE


R. No. 36,197